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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,951	09/20/2000	Friedhelm Beckmann	2641/207-168	7347
24131	7590	06/25/2004	EXAMINER	
LERNER AND GREENBERG, PA P O BOX 2480 HOLLYWOOD, FL 33022-2480			MANLOVE, SHALIE A	
		ART UNIT	PAPER NUMBER	
		1755		

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

<b>Application No.</b> 09/666,951  <b>Examiner</b> Shalie A. Manlove	<b>Applicant(s)</b> BECKMANN, FRIEDHELM	
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*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 19 April 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)               |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/17/2004</u> . | 6) <input type="checkbox"/> Other: _____ .  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on April 19, 2004 has been entered.

### ***Rejections Repeated***

2. The 35 U.S.C. § 112, first paragraph rejections of claims 1-3, 10 and 15 are repeated for reasons previously of record in paper 13, page 2, paragraph #2. Claim 1-3, 10 and 15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification teaches the solid core material is coated with activatable material but fails to define “activatable material” (page 3, line 14). Applicants are cautioned against the introduction of new matter.

3. The 35 U.S.C. 112, second paragraph rejections of claims 1-18 are repeated for reasons previously of record in paper 13, page 2, paragraph #4.

Applicant argues that, “the activatable material disclosed in the specification refers to material which is activatable to foam, and if activated, form foam. In other words, the activatable material disclosed in the specification is activatable foamable material”.

**The activatable foamable material is not clearly taught so that one of ordinary skill in the art would recognize the substance known as the activatable foamable material.**

**Specific materials are neither identified in the specification nor claimed. Claims directed to materials characterized by physical properties alone and no specific composition are vague, indefinite and invalid. Ex parte Slob 157 USPQ 172**

4. The 35 U.S.C. 103 rejections of claims 1-14 over Thum (US 5194199) in view of Soderberg (US 5160465) are repeated for reasons previously of record in paper 13, page 4, paragraph #8.

With respect to Applicant’s argue that, Soderberg does not teach the step of “subjecting all interior areas of the assembly to a corrosion protection agent”. Additionally, the Applicant argues, “ if the interior areas of the assembly in Soderberg would be subject to anti-corrosion treatment, then it would not be necessary to use a non-moisture-absorbing foam to minimize corrosion”.

**Soderberg discloses submitting the vehicle to low temperature anti-corrosion treatment (col. 3, lines 1-10). The examiner deems the vehicle to contain an interior and an exterior, thus by submitting the vehicle to treatment; one would be applying treatment to the exterior as well as the interior.**

**With respect to the non-moisture-absorbing foam disclosed by Soderberg, it would be obvious to one of ordinary skill in the art to use non-moisture-absorbing foam in order to prevent the introduction of moisture from any source into the process.**

5. In response to the Applicant's argument that there is no suggestion to combine the references, **the examiner recognizes that references cannot arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975)**

**The test for combining is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin 170 USPQ 209 (CCPA 1971)**

**In this case the references combined disclose a hollow section with internal reinforcement as is similarly presented in the instant application. The Examiner deems the references applicable as prior art in respect to the Applicant's invention.**

#### *Withdrawn Rejections*

6. The 35 U.S.C. 102 rejections of record in paper 13, page 3, paragraph #6 have been withdrawn due to Applicant's amendment in paper#13.

7. Applicant's arguments with respect to claims 15-18 have been considered but are moot in view of the new ground of rejection.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thum (US 5194199) and Soderberg (US 5160465) in view of Russell (WO 93/05103). Thum discloses a beam like structural part having a core of lightweight material comprising polyurethane or aluminum foam (fig.1, col. 2, lines 17-19) and Soderberg teaches a process of insulating a body by submitting the body to anti-corrosion treatment and then to a high temperature curing treatment whereby the foaming material expands and adheres to the surrounding metal surface and forms a sound and moisture insulating plug of closed-cell foam (col.3, lines 2-10). Neither Thum nor Soderberg teach the activatable material to be a foamed/unfoamed metallic material, or synthetic material reinforced with fibers.

However, Russell teaches the activatable material to be a mixture of plastics material and reinforcing fibers (page 1, lines 34-39) for the purpose of reinforcing a structure. In

addition the reference teaches strengthening only in some areas for the purpose of structural integrity (page 3, lines 6-7).

Therefore, it would have been obvious to one of ordinary skill in the art to combine the structural body of Thum, comprising a hollow member for insulation, with the process of insulating the body as taught by Soderberg with the activatable foamable material and the method of strengthening portions as taught by Russell to create a body comprising a hollow section that has internal reinforcement in full or parts in order to improve the performance of the structure.

***Information Disclosure Statement***

DE 198 56 255 C1, DE 42 03 460 A1, and FR2 749 263 have been considered in respect to the abstract submitted by the Applicant.

**New Rejections**

***Claim Rejections - 35 USC § 112***

- 10 The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 15-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specification does not teach solid core disposed inside said outer plate substantially symmetrically, accordingly this added material is new matter.

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12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

13. Claims 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Symmetrically is indefinite because the term has several different meanings and is also unclear which definition/meaning applicant is using. Accordingly, when there is more than one definition for a term, it is incumbent upon applicant to make clear which definition is being relied upon to claim the invention. Until the meaning of a term or phrase used in a claim is clear, a rejection under 35 U.S.C. 112, second paragraph is appropriate. It is appropriate to compare the meaning of terms given in technical dictionaries in order to ascertain the accepted meaning of a term in the art. *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

What is meant by *substantially symmetrically*?

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shalie A. Manlove whose telephone number is (571) 272-1372. The examiner can normally be reached on M-TH 6:30-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on (571) 272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shalie A. Manlove  
Examiner  
Art Unit 1755

  
**C. MELISSA KOSLOW**  
**PRIMARY EXAMINER**

June 23, 2004